



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/647,914

08/26/2003

Brian K. Aegerter

114183.00020

2441

63462 7590 02/12/2009
ROCKEY, DEPKE & LYONS, LLC
SEARS TOWER
SUITE 5450
CHICAGO, IL 60606-6306

EXAMINER

BLAN, NICOLE R

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

02/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/647,914	Applicant(s) AEGERTER ET AL.	
	Examiner NICOLE BLAN	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-83 and 85-99 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67-83 and 85-99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 67-83 and 85-99 are currently pending in the application.
2. At this time, the Office of Petitions has not yet reached a decision with regards to the Oath/Declaration. Once a decision has been reached, the Applicants' will be notified of the decision.

Response to Arguments

3. Applicant's arguments filed October 20, 2008 have been fully considered but they are not persuasive.
4. In response to applicant's argument regarding it being unnecessary to file under 37 CFR 41.202 instead of 37 CFR 1.131, the Examiner respectfully disagrees. As per MPEP 2305, it states that ordinarily an applicant may use an affidavit of prior invention under 37 CFR 1.131 to overcome a rejection under 35 U.S.C. 102(a) or 102(e). An exception to the rule arises when the reference is a patent or application published under 35 U.S.C. 122(b) and the reference has claims directed to the same patentable invention as the application claims being rejected. The subject matter claimed in the instant application is directed to the same patentable invention; therefore, it was not proper to file a declaration under 37 CFR 1.131 but would have been proper to file under 37 CFR 41.202. Therefore, it is proper and necessary to file under 37 CFR 41.202.
5. In response to applicant's arguments pertaining to what the declaration provided by Mr. Peace teaches, the Examiner does not find them persuasive. The Examiner has reviewed the declaration provided and maintains that it is not commensurate in scope with the claims. Contrary to what the applicant's have argued, the declaration does not show any signs of

Art Unit: 1792

teaching that the substrate is rotated. Furthermore, it does not discuss or mention the difference in flow rates between the first and second fluids, does not disclose the use of deionized water as a rinsing fluid or hydrochloric acid as the dissolving fluid, there is no support for delivering the rinse and dissolving fluids independently of mechanical scrubbing, and there is no mention of edge cleaning or edge exclusion zones during the cleaning process. Merely stating that it is obviously shown is not enough to demonstrate the appropriateness of an interference.

Furthermore, because the evidence was filed under 37 CFR 1.131 and not under 37 41.202 as is required in order to demonstrate the appropriateness of an interference, the Examiner maintains that the declaration is not valid because it was not signed by all of the inventors.

As such, the '865 patent will not be removed as prior art and the previous rejection is maintained. Furthermore, the application will not be placed in condition for allowance; thus, no interference has been declared.

6. In response to applicant's argument regarding the rejections under 112, 1st paragraph, the Examiner does not find this persuasive. The claim(s) contain(s) subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This subject matter is in the third line of claims 68, 71, 81 and 97, "... delivering the rinse onto the first surface at a greater flow rate compared to a flow rate of ..." and in the last line of claims 72 and 88, "...occurs independently of mechanical scrubbing." Even though independent claim 67 is not rejected over 35 U.S.C. 112, 1st paragraph, this does not diminish the fact that dependent claims are properly rejected under this section for failing to comply with

Art Unit: 1792

the written description requirement. As such, the rejections under 35 U.S.C. 112, 1st paragraph are proper and are maintained.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 68, 71-72, 81, 88, and 97 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the third line of claims 68, 71, 81, and 97, "... delivering the rinse onto the first surface at a greater flow rate compared to a flow rate of ..." is not supported in the original disclosure. Even though the specification describes controlling the extent to which the etching fluid is applied by controlling its flow rate, it does not describe that the flow rate of the rinsing fluid is greater than that of the dissolving fluid.

In the last line of claims 72 and 88, "...occurs independently of mechanical scrubbing" is not supported in the original disclosure. The original disclosure is silent with respect to the cleaning process being completed independent of scrubbing.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 67-83 and 85-99 stand rejected under 35 U.S.C. 102 (a/e) as being anticipated by Lloyd et al. (U.S. Patent 6,290,865), as per the reasons clearly stated in the final office action on the merits dated October 13, 2006.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE BLAN whose telephone number is (571)270-1838. The examiner can normally be reached on Monday - Thursday 8-5 and alternating Fridays 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on 571-272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

Art Unit: 1792

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicole Blan/
Examiner, Art Unit 1792

/Michael Cleveland/
Supervisory Patent Examiner, Art Unit 1792